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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/621,670	07/24/2000	Mark Ashby	032005-068	6902

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EXAMINER

IZAGUIRRE, ISMAEL

ART UNIT	PAPER NUMBER
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3765

DATE MAILED: 07/14/2003

12

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/621,670

Applicant(s)

ASHBY, MARK

Examiner

Ismael Izaguirre

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 28 May 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-48 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 14-18 and 20-24 is/are allowed.
- 6) ☒ Claim(s) 1,3-5,7-13,19,25-27,29-32,35,36,38,40-42 and 44-48 is/are rejected.
- 7) ☒ Claim(s) 2,6,28,33,34,37,39 and 43 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 9,11.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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### **DETAILED ACTION**

The Examiner is appreciative of the changes made to the specification and language of the claims. These have been duly noted and considered.

#### ***Specification***

The insert to the specification concerning the priority claim to 09/613, 439 has been noted. However, it is unclear what type of priority is being defined. Is this application intended as a child of parent 09/613,439? Is this application a continuation, continuation-in-part, or divisional of such application. Applicant is asked what kind of relation are these two applications and what is their common disclosure.

#### ***CLAIMS***

##### ***Summary***

Claims 1,14,25,38,44 and 45 are the independent claims under consideration in this Office Action.

Claims 2-13,15-24,26-37,39-43 and 46-48 are the dependent claims under consideration in this Office Action.

##### ***Claim Language***

Concerning the language of the claims, after a further scrutiny of this, the following is submitted for applicant's consideration:

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***Claim Discrepancies***

In claims 7,14, and 33, with line 3 of claim 7, for example, the punctuation between “distal” and “end” is unclear. This should be deleted.

***Claim Rejections - 35 U.S.C. § 112***

Claims 7-12,19,35,36 and 46-48 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Referring to claim 7, line 3, the letter “b” is confusing. This letter should be capitalized as per the drawings or enclosed within parenthesis.

Referring to claim 19, last line, the number “6” has no clear meaning.

Referring to claim 35, line 2, the word “portions” has no clear meaning. What plurality of proximal ends does this refer to?

Referring to claims 46-48, the scope of these claims is unclear. These refer to a “method” of claims 1 or 2, however an apparatus is defined in claims 1 or 2. This should be corrected.

***Claim Patentability***

Concerning the Patentability of the claims, Cragg et al. Remains applicable for the above reasons. Janzen, upon closer inspection, is applicable as well. The following is submitted for Applicant's consideration:

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***Claim Rejections - 35 U.S.C. § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1,3-5,13,25-27,29-32,38,42 and 44 are rejected under 35 U.S.C. § 102(b) as being anticipated by Cragg et al. (6,162,192).

Cragg et al. teach an apparatus for inhibiting blood loss and marking the distance between the surface of a patient and a blood vessel. Cragg et al. teach the apparatus including a vent tube 12 (figure 1, middle figure). The vent tube includes a handle 44 with a cannula or staging chamber 34. A control head attached to the distal end of the vent tube includes a marking ring 52, a lumen or delivery cannula 36 and lateral holes 46 at the control tip of the control head communicating with the lumen 36. The vent tube and control head accommodate a guide wire 26, which would inherently include a control tip within the cannula 36 and 34 for penetrating through the patient and a blood vessel 102. When the tubular shaft is placed at the border or boundary of the vessel a marker 52 is then slid into position so as to mark the depth. A pledget

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40 is placed in the cannula 34 and is pushed along by a pledget pusher 50 fitting over the vent shaft 12. Accordingly, the pledget is positioned for preventing blood loss at the puncture site.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 38, 40-42, 44 and 45 are rejected under 35 U.S.C. § 102(b) as being anticipated by Janzen (5,437,631).

Janzen teach a method for measuring the distance between an epidermal outer surface and the outer surface of a blood vessel and at least partially controlling the blood flow through a puncture site of a blood vessel wall. Janzen teaches advancing a control tip 32, 28, 22 through a subcutaneous tissue and into a blood vessel 12 through the puncture (figures 1 or 2) and advancing a tubular shaft 42 (figures 5 or 6, for example) over the control tip until a distal end of the tubular shaft engages the outer surface of the blood vessel (figure 5) and positioning a marker 47 along the tubular shaft against the epidermal outer surface 16. The advancing of the tip is performed before the step of advancing the tubular shaft. The advancement of the tip is stopped after blood flashes out a proximal end of the control tip and the advancement of the shaft is stopped after the tubular shaft bumps into the vessel wall.

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***Allowable Subject Matter***

Claims 14-18,20-24 are allowable over the prior art of record.

Claims 7-12,19,35,36 and 46-48 would be allowable if rewritten to overcome the rejection under 35 U.S.C. § 112 and to include all of the limitations of the base claim and any intervening claims.

Claims 2,6,28,33,34,37,39 and 43 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***INQUIRIES***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mr. Ismael Izaguirre located in CP2-4B18 whose telephone number is (703) 308-0892. The examiner can normally be reached on Monday to Friday from 9:30 to 6:00.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0861.



**Ismael Izaguirre**  
***Primary Examiner***  
***Art Unit 3765***

II  
July 9, 2003